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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/889,825 07/08/97 LEV

A 6530.0060

EXAMINER

QM12/0303

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PEEFLEY, M

ART UNIT

PAPER NUMBER

3739

14

DATE MAILED:

03/03/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/889,825

Applicant(s)

LEV, AVIGDOR

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 April 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 48-79 and 87-91 is/are allowed.
- 6) ☒ Claim(s) 1-47 and 80-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,9.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_.

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This Office action is in response to applicant's amendment received April 30, 1999. Also, applicant's preliminary amendment adding claims 80-91 has been considered by the examiner. The following is an action on pending claims 1-91.

### ***Reissue Applications***

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-47 and 80-91 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

### ***Claim Rejections - 35 USC § 101***

Claims 80-91 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims positively recite the human body by reciting either the direct measurement of or contact with portions of the body. For instance, claim 80 recites in lines 9-10: "...sensing device detects a temperature of a wall of the cavity.." This recitation requires a direct relationship between the device and the body. In order to

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overcome this rejection, it is suggested the language be amended to recite: "...sensing device is adapted to detect a temperature of a wall of the cavity.."

Similarly, claim 83, lines 9-10 recites the sensing device "contacts a wall of the organ". This language should be amended to recite that the sensing device "is adapted to contact a wall of the organ".

Amendments similar to those addressed above should also be made to claims 81, 85-88, 90 and 91.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-47 and 83-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As asserted in the previous office action, many of the claims are indefinite with the scope of the invention, particularly with whether or not the fluid is being positively recited as part of the invention.

For instance, claim 1 recites in the preamble a device which is "adapted to receive multiple injected liquid fluid flows". This recitation implies that the fluid, per se, is not being claimed as part of the invention. However, the preamble continues to state that the antenna is "submerged within a fluid flow". Now a fluid is being positively recited. The claim continues to recite that the antenna is "adapted to be submerged

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within a flow". It is unclear if the fluid flow(s) is/are being claimed as part of the invention, or if it merely being inferentially recited as an intended use of the device. For the purposes of applying prior art, it is assumed the fluid is being positively recited. However, the claims must be amended to either positively recite the fluid (i.e. recite the fluid, fluid source, etc.) or be amended to remove all positive inclusion of the fluid from the claims.

Similarly, claims 83, 85 and 86 are all unclear with regard to the limitations directed towards the fluid. These claims recite channels for providing and receiving a fluid (not a positive recitation of the fluid), the set forth the limitation of providing the fluid to the body. Applicant must either positively recite the fluid, or maintain consistent inferential language which does not require the fluid.

Finally, claim 84 lacks proper antecedent basis for "the heating substance". It is noted that claim 83 recites "a treatment substance" in lines 4-5. It appears that either "treatment" should be replaced with "heating" in line 4 of claim 83, or "heating" should be replaced with "treatment" in line 1 of claim 84.

### ***Response to Arguments***

Applicant's arguments regarding the prior art rejections of the claims have been deemed persuasive. In particular, the prior art fails to disclose the specific catheter device whereby a fluid is provided in contact with the antenna and to tissue. While Turner et al disclose a cooling fluid and multiple fluid flow ports, there is no disclosure in

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Turner et al of providing the fluid to tissue. Rather, Turner et al merely provides a distal port for the removal of fluid (i.e. urine) from tissue.

Other prior art antenna catheter devices also fail to disclose the specific cooling fluid and temperature arrangements as set forth in the application claims.

***Allowable Subject Matter***

Claims 48-79 and 87-91 are allowable over the prior art of record.

***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Edwards et al ('730) disclose a device which includes a catheter and a distal balloon. A fluid is provided through the balloon to tissue, and an RF energy source is used to treat tissue. Temperature sensors are also provided to monitor tissue temperature. The Edwards et al disclosure does not qualify as prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on 9 hour.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda M Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Michael Peffley/mp  
Primary Examiner  
Art Unit 3739  
February 15, 2000